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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/027,624	12/19/2001	John D. Richardson	01-329	2936

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EXAMINER

GREIMEL, JOCELYN

ART UNIT PAPER NUMBER

3693

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/05/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/027,624

Applicant(s)

RICHARDSON, JOHN D.

Examiner

Jocelyn Greimel

Art Unit

3693

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-75 is/are pending in the application.
- 4a) Of the above claim(s) 30,31,61,62 and 64-68 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-75 is/are rejected.
- 7) ☒ Claim(s) 6 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This communication is in response to Applicant's application filed 19 December 2001. In response to a restriction requirement of 21 September 2006, Applicant elected Group 1, claims 1-29, 32-60, 63 and new claims 69-75. Claims 1-75 are pending and are presented to be examined upon their merits. Claims 30-31, 61-62 and 64-68 have been withdrawn. Claims 1, 32, 63 and 69 are independent claims.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 69 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims reads a "product for determining a price associated with a warranty" but no price is determined in the claimed steps. Appropriate correction is required.

Claim Objections

4. Claim 6 is objected to because of the following informalities: it appears the claim should read "and determining a base line" – "the" needs to be deleted. Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. **Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Merkin et al. (US Patent Pub. No. US 2003/0074294 A1, hereinafter Merkin).** In reference to claim 1, 32 and 63, Merkin discloses a method, system and computer program which can be used to determine a price associated with a warranty:

- a. establishing an identifier associated with the equipment (0007-0009; 0031-0034);

- b. establishing a first set of warranty characteristics (0032-0034);
- c. determining a baseline premium based on the identifier and the first set of warranty characteristics (0032-0034);
- d. establishing a second set of warranty characteristics (0032-0034);
- e. determining at least one modifier as a function of the second set of warranty of characteristics (0032-0034); and
- f. modifying the baseline premium, as a function of the at least one modifier to determine the warranty price (0032-0034).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

- 1. Determining the scope and contents of the prior art.
- 2. Ascertaining the differences between the prior art and the claims at issue.
- 3. Resolving the level of ordinary skill in the pertinent art.
- 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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9. Claims 2-29, 33-60 and 69-75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Merkin in view of Chene et al (US Patent No. 6,587,768 B2, hereinafter Chene).

10. In reference to claims 3, 5, 6, 7, 14, 18, 19, 20 and 21, Merkin discloses a method, system and computer program:

g. Wherein determining a base line premium includes determining a parts differential and a labor differential, wherein the base line premium is a function of the parts premium, the labor premium, the parts differential and the labor differential;

h. Wherein the total equipment term is defined by a length of time since a purchase date;

i. Wherein the second set of warranty characteristics includes a warranty coverage;

j. Establishing a level of coverage of the equipment and determining a coverage modifier as a function of the level of coverage;

k. Wherein the equipment includes a first portion and a second portion and the level of coverage includes one of a warranty for the first portion or warranty for the first portion and the second portion;

l. Wherein the equipment includes a first portion and a second portion, and the level of coverage includes one of warranty coverage for the first portion,

warranty coverage for the first portion and the second portion, or total warranty coverage for the equipment (0007-0009; 0031-0034).

Merkin applies to a baseline computer and specific upgrades, which are evaluated and used to determine an appropriate warranty. However, Merkin does not disclose specific warranty characteristics related to the equipment (such as the number of hours of use, the level of coverage.

11. Chene discloses a system where powertrain (equipment/vehicle) warranty data is provided via the vehicle onboard computer. Chene discloses:

- m. Wherein the first set of warranty characteristics includes at least one of a term or a number of hours;
- n. Selecting a term for the warranty;
- o. Wherein the term includes a number of years and determining a base line premium includes determining a parts premium and determining a labor premium (col. 2, line 63 – col. 3, line 10);

Chene specifically discloses warranty information such as length of coverage. It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the warranty calculations of Merkin with the warranty characteristics of powertrains of Chene because it would be an efficient way to calculate a warranty for equipment, which has multiple warranty characteristics.

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12. In reference to claims 4, 8-13, 15-17 and 22-29, Merkin discloses a method, system and computer program including:

- p. establishing a product family, a list of model numbers associated with the product family and an identifier associated with the equipment including a product family and a list of model numbers associated with the product family;
- q. wherein the warranty characteristics include a geographic region, country of operation; government modifier if the transaction includes a government; a customer service agreement modifier or an industry segment modifier;
- r. wherein the warranty term has a sub-term and a second sub-term and determining the baseline premium includes a first sub-term premium and a second sub-term premium; selecting a term for the first portion and the second portion;
- s. wherein the equipment includes a powertrain and a hydraulics system and term; term is length of time since purchase date; term is defined by hours of operation;
- t. wherein there is a total term for the equipment which is defined by a length of time since purchase date or hours of operation (0007-0009; 0031-0034).

Merkin applies to a baseline computer and specific upgrades, which are evaluated and used to determine an appropriate warranty. However, Merkin does not disclose specific warranty characteristics related to the equipment (such as the number of hours of use, the level of coverage. Chene discloses a system where powertrain (equipment/vehicle) warranty data is provided via the vehicle onboard computer. Chene specifically

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discloses warranty information such as length of coverage (col. 2, line 63 – col. 3, line 10). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the warranty calculations of Merkin with the warranty characteristics of powertrains of Chene because it would be an efficient way to calculate a warranty for equipment, which has multiple warranty characteristics.

13. In reference to claims 69-75, Merkin discloses a method, system and computer program for determining a price associated with equipment including:

- u. Establishing an identifier associated with the equipment, wherein the equipment includes one or more portions;
- v. Establishing a first set of warranty characteristics, including geographic regions, including one or more countries;
- w. Determining a baseline premium associated with the warranty based on the identifier and the first set of warranty characteristics
- x. Establishing a second set of warranty characteristics and determining at least on modifier as a function of the second set of warranty characteristics and modifying the baseline premium as a function of the modifier and the warranty price
- y. Wherein the modifier maintains the baseline premium at the same level;
- z. Wherein the second set of warranty characteristics includes a level of coverage; the level of coverage includes: one or more portions of the equipment

or one or more parts or labor or a geographic modifier based on at least one of the plurality of geographic regions (0007-0009; 0031-0034).

Merkin applies to a baseline computer and specific upgrades, which are evaluated and used to determine an appropriate warranty. However, Merkin does not disclose specific warranty characteristics related to the equipment (such as the number of hours of use, the level of coverage. Chene discloses a system where powertrain (equipment/vehicle) warranty data is provided via the vehicle onboard computer. Chene specifically discloses warranty information such as length of coverage. It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the warranty calculations of Merkin with the warranty characteristics of powertrains of Chene because it would be an efficient way to calculate a warranty for equipment, which has multiple warranty characteristics.

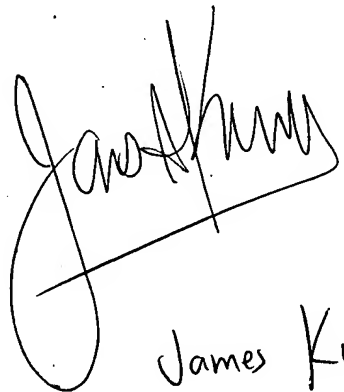
Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jocelyn Greimel whose telephone number is (571) 272-3734. The examiner can normally be reached on Monday - Friday 8:30 AM - 4:30 PM EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jocelyn Greimel
Examiner, Art Unit 3693
December 18, 2006

 12/29/06
James Kramer